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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/617,811

07/14/2003

Jin-Young Lee

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4174

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EXAMINER

LEE, CYNTHIA K

ART UNIT

PAPER NUMBER

1745

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/617,811	<b>Applicant(s)</b> LEE ET AL.	
	<b>Examiner</b> Cynthia Lee	<b>Art Unit</b> 1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

This Office Action is responsive to the amendment filed on 11/14/2006. Claims 1-12 and 14-16 are pending. Claims 14-16 are withdrawn from further consideration as being drawn to a non-elected invention. Claim 1 has been amended. Applicant's arguments have been considered and are persuasive. Thus, claims 1-12 are rejected for reasons set forth herein below.

#### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 9-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Naoki (JP 11-273731).

Naoki discloses a lithium ion secondary battery comprising a positive electrode including a material that is capable of reversible intercalation/deintercalation of lithium ions as a positive material (particularly  $\text{LiCoO}_2$ ,  $\text{LiMn}_2\text{O}_4$ ,  $\text{LiNiO}_2$ ), a negative electrode including a material capable of reversible intercalation/deintercalation of lithium ions as a negative material, a separator interposed between the positive and negative

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electrodes, and an electrolyte on the separator wherein the electrolyte includes a non-aqueous organic solvent, a lithium salt, and a linear polymer having P=O bonds (Abstract and [0028, 0029, 0031, 0033]). (Applicant's claim 1)

Naoki discloses using non-aqueous organic solvents comprising cyclic and linear carbonates, such as ethylene carbonate (EC), propylene carbonate (PC), dimethyl carbonate (DMC), methylethyl carbonate (MEC), diethylene carbonate (DEC) [0028]. (Applicant's claims 2-4)

Naoki discloses lithium salts comprising  $\text{LiPF}_6$ ,  $\text{LiBF}_4$ ,  $\text{LiClO}_4$ ,  $\text{LiN}(\text{SO}_2\text{CF}_3)_2$ ,  $\text{LiC}(\text{SO}_2\text{CF}_3)_3$  in the amount of between 1M and 1.7M [0029]. (Applicant's claims 9 and 10)

Naoki discloses wherein the electrolyte includes a polymerized phosphoric ester, as illustrated as formula. 3.

The amount of the phosphoric ester polymer is 5 vol%. Naoki discloses that the phosphoric ester polymer is 5 vol% and not wt%. Naoki does not disclose the density of the polymer to define a wt% of polymer in the electrolyte (applicant's claim 1). The Office notes that the density of most materials is about 1g/ml and thus, vol% is approximately weight %. MPEP states that prior art which teaches a range overlapping or touching the claimed range anticipates if the prior art range discloses the claimed range with "sufficient specificity." See 2131.03.

Should it not be anticipatory, Naoki discloses that phosphoric ester polymers impart flameproofing properties to the electrolyte solution, thus clearly teaching that phosphoric ester polymer is a result effective variable. It has been held by the courts

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that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05.

Further, it has been held that a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.05. It has been held by the courts that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Swain et. al.*, 33 CCPA 1250, 156 F.2d 239, 70 USPQ 412.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Naoki (JP 11-273731) in view of Yeager (US 2002/0177027).

Naoki discloses all the elements of claim 11 and is incorporated herein. Naoki does not disclose wherein the electrolyte includes a phosphonate as claimed in claim 12 in the intermediate product. However, Yeager discloses that dialkylvinylphosphonates, such as diethylvinylphosphonate ([0071], lines 11-12 from the bottom) are used as

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flame retardants. It is commonly known in the art that thermal instability and explosions are problems with batteries, particularly Li ion batteries, as disclosed by Naoki [0003].

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to polymerize dialkylvinylphosphonates instead of a phosphoric ester for the benefit of reducing explosions and thus, making a safer Li ion battery.

Considering the limited number of species in the class of dialkylvinylphosphonates, it is found that dimethylvinylphosphonate and dipropylvinylphosphonate are obvious for the same reason given above.

Yeager teaches that dialkylvinylphosphonates are flame retardants, thus clearly teaching that dialkylvinylphosphonate is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05.

Claims 1, 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naoki (JP 11-273731) in view of Tsutsumi (US 6645671).

Naoki discloses a lithium ion secondary battery comprising a positive electrode including a material that is capable of reversible intercalation/deintercalation of lithium ions as a positive material (particularly  $\text{LiCoO}_2$ ,  $\text{LiMn}_2\text{O}_4$ ,  $\text{LiNiO}_2$ ), a negative electrode including a material capable of reversible intercalation/deintercalation of lithium ions as a negative material, a separator interposed between the positive and negative electrodes, and an electrolyte on the separator wherein the electrolyte includes a non-

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aqueous organic solvent, a lithium salt, and a linear polymer having P=O bonds (Abstract and [0028, 0029, 0031, 0033]). (Applicant's claim 1)

Naoki discloses of using a phosphoric ester polymer in the electrolyte solution, see Fig. 3.

The amount of the phosphoric ester polymer is 5 vol%. Naoki discloses that the phosphoric ester polymer is 5 vol% and not wt%. Naoki does not disclose the density of the polymer to define a wt% of polymer in the electrolyte (applicant's claim 1). The Office notes that the density of most materials is about 1g/ml and thus, vol% is approximately weight %. MPEP states that prior art which teaches a range overlapping or touching the claimed range anticipates if the prior art range discloses the claimed range with "sufficient specificity." See 2131.03.

Should it not be anticipatory, Naoki discloses that phosphoric ester polymers impart flameproofing properties to the electrolyte solution, thus clearly teaching that phosphoric ester polymer is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05.

Further, it has been held that a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.05. It has been held by the courts that where the general conditions of a claim are

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disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Swain et. al., 33 CCPA 1250, 156 F.2d 239, 70 USPQ 412.

Naoki discloses using non-aqueous organic solvents comprising carbonates, such as ethylene carbonate (EC), propylene carbonate (PC), dimethyl carbonate (DMC), methylethyl carbonate (MEC), diethylene carbonate (DEC) [0028]. (Applicant's claims 2-4) and does not disclose that the non-aqueous solvent comprises a mixed solvent of a carbonate solvent and an aromatic hydrocarbon solvent (applicant's claims 5-8). However, Tsutsumi discloses of using a combination of high-permittivity solvent and a low-viscosity solvent for the benefit of obtaining high charging/discharging efficiency, as well as to keep the viscosity low. Examples of high-permittivity solvents include cyclic carbonates (7:1-8). Examples of aromatic hydrocarbons include benzene, toluene, and xylene, as low-viscosity solvents (7:1-25). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add an aromatic hydrocarbon, such as benzene, toluene, and xylene to Naoki's Li ion battery for the benefit of reducing the electrolyte viscosity.

Tsutsumi discloses of using the high-permittivity solvents and low viscosity solvents in a volume ratio of preferable 1:4 to 2:1, preferably 1:2 to 1:1 (7:40-45). Carbonate solvent is a high permittivity solvent and aromatic hydrocarbon is a low viscosity solvent and it has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and



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thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05.

### ***Response to Arguments***

Applicant's arguments filed 11/14/2007 have been considered but are moot in view of the new ground(s) of rejection.

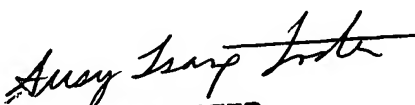
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Lee whose telephone number is 571-272-8699. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ckl

  
SUSYTSANG-FOSTER  
PRIMARY EXAMINER